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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,710	05/30/2001	Henri Kwok Wai Lee	P07140US00/D	5851

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT PAPER NUMBER

2873

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,710

Applicant(s)

LEE, HENRI KWOK WAI

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because it does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration. Specifically, the residence information was left blank on the declaration.

Specification

The specification is objected to because this application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use. The following section headings are preferably used within the specification where appropriate and each of the numbered items should appear in upper case, without underlining or bold type, as section headings.

1. Background of the Invention.
2. Summary of the Invention.

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3. Brief Description of the Drawings.
4. Detailed Description of the Preferred Embodiments.

Claim Objections

Claims 11 and 25-27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, in order to converge light the optical element would inherently have to include or be a lens and therefore claiming the optical elements as lenses is not further limiting.

The claims are replete with numerous typographical errors and it is requested that the claims be reviewed carefully. The following are errors that were noted by the examiner:

1. Claim 1, "said it bases";
2. Claim 3, "bass lenses" (assumed to mean "base lenses");
3. In claim 8, "converging ' means" should be corrected to "converging means";
4. Claim 11, "Comprises" (is capitalized in the middle of the claim);
5. Claim 12, there's a period in the middle of the claim and "each of' " should be corrected;
6. Claim 14 says "bass lancer" (assumed to mean "base lenses") and the claim ends in two periods;
7. Claims 22 and 38 say, "fox reducing" and 'fox avoiding" ("fox assumed to mean "for");
8. Claim 27 says "bane-in prisms" (assumed to mean "base-in prisms");

9. Claim 32, "axe" should be "are");
10. Claim 39 has numerous out of place capitalizations and the claim lacks grammatical clarity;
11. Claim 41 should say, "wherein said lenses are approximately..."; and
12. Claim 47, the comma in the second line should be deleted.

Claim Rejections - 35 USC § 112

Claims 1-4 and 8-9 (and dependent claims 5-18) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claim 1-4, that part of the claim stating, "when said apparatus is worn by a user" renders the claim vague and indefinite. Specifically, applicant is claiming "An apparatus for avoiding muscular fatigue" but has not claimed that the apparatus is being worn by a user and if "worn by a user" is intended as a limitation then it needs to be more positively and distinctly claimed.

In reference to claims 8-9, the claims state that converging means "includes or is additionally" and it is not clear what the distinction between the two is rendering the claim vague and indefinite. It is suggested that "or is additionally" be deleted to provide clarity.

Duplicate Claims

Applicant is advised that should claim 36 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both

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cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-7, 10-15, 17-22, 24-29, 31, 34-40, 43-44 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Shapiro.

Shapiro reads on these claims by disclosing the limitations therein including the following: an apparatus and method for avoiding ocular muscular fatigue (column 1, line 9); specifically through the use of spectacles (Figures 2, 3, 4A and 4B); comprising binocular light converging means (Figures 2, 3, 4A and 4B); comprising two optical elements (Figures 3, 4A and 4B); for converging incident light (Figures 2 and 3); thereby reducing ocular convergence demand when worn (column 1, line 9, column 2, line 21 to column 3, line 50); wherein each optical element comprises a spherical optical wedge with a base (Figures 2 and 3, column 1, line 9, column 4, line 23-29); the bases being adjacent to form base-in prisms (Figure 3, column 1, line 9); adjusting means to adjust the separation of the elements according to pupil separation of a user (column 4, line 5); the optical elements within the range of 0.2 to 10 base lenses (column 3, line 19); the optical elements are additionally prescription (column 3, lines 19-26). The lenses would

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inherently be one of polycarbonate, acrylic or polymeric plastic, this being reasonably upon Shapiro disclosing the lenses as being made of plastic (column 3, line 37) and polycarbonate, acrylic or polymeric plastic are all well known plastic materials used to make spectacle lenses. The lenses of Shapiro would inherently magnify light, this being reasonably based upon the use of positive powered base-in prisms, which would inherently produce this effect, as well as upon the similarity in structure between the lenses of Shapiro and that of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 16, 23, 30 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro.

In reference to claims 5, 23 and 42, Shapiro discloses as is set forth above but does not specifically disclose an embodiment in which the lenses are integrally formed. The examiner take Judicial Notice that it is well known in the art of eyeglass lenses for such lenses to be formed as either two separate lenses, such as eyeglasses separated by a nose piece, or integrally formed, such as wrap around lenses, depending upon design choice of the user. Therefore, in reference to claims 5, 23 and 42, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the eyeglass lenses of Shapiro as integrally formed since it is well known in the

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art of eyeglass lenses, for such lenses to be formed as either two separate lenses, such as eyeglasses separated by a nose piece, or integrally formed, such as wrap around lenses, depending upon the design choice of the user. In reference to claims 16, 30 and 41, Shapiro discloses that the lenses can have base 1 (column 3, line 19) which is "approximately" 0.5 base lenses. Regardless, Shapiro teaches that the base diopter can be varied depending upon the desired optical convergence (column 4, line 58 to column 5, line 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lenses of Shapiro with approximately 0.5 base since Shapiro teaches that the base diopter can be varied depending upon the desired optical convergence and therefore the lenses could have a base of approximately 0.5 base as a matter of design choice depending upon the desired convergence required.

Claims 8-9, 32-33 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro in view of Beard.

In reference to these claims, Shapiro discloses as is set forth above and further discloses that the eyeglass lenses can further comprise filters (column 5, lines 50-62). Beard teaches that eyeglass lenses that are concerned about muscular fatigue and that utilize optical filters (column 7, lines 27-47), can comprise a color filter, particularly to reduce the intensity of transmitted yellow light (column 7, lines 27-47) since the human eye is particularly sensitive to yellow light (column 7, line 35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the eyeglass lenses of Shapiro as further comprising a color filter, particularly to

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reduce the intensity of yellow light since Shapiro discloses that the eyeglass lenses can further comprise filters and Beard teaches that eyeglass lenses that are concerned about muscular fatigue and that utilize optical filters, can comprise a color filter, particularly to reduce the intensity of transmitted yellow light since the human eye is particularly sensitive to yellow light.

Prior Art Citations

Levy, Kanda patent no. 4,886,340, Kanda patent no. 4,820,035, and Japanese document no. 61-72220 would all read on a number of the above rejected claims, however, such rejection would have been repetitive. Levy further discloses how base-in prism lenses will inherently provide an increase in magnification (column 4, line 54).

For applicant's information, in reference to independent claims 2-4, 21-22, and 37-38, due to the extreme broadness of the claims, numerous references could have been applied. Specifically, with reference to independent claims 2 and 22, any pair of binoculars that are concerned with ocular fatigue would read on these claims since binoculars inherently are adjustable to provide separation of the two optical elements based upon the location of the eyes, and therefore based upon the pupil separation of the user. Specifically, in reference to independent claims 3-4, 21 and 37-38, any prescription lens, particularly with a base between the broad range of 0.2 to 10 base, that is concerned with ocular fatigue would read on these claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703)

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308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

0956

A handwritten signature in black ink, appearing to read 'J. Schwartz', with a large, stylized loop at the end.

Jordan M. Schwartz
Primary Examiner
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February 26, 2003